

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
James P. Elia) Group Art Unit: 1647
)
Serial No.: 09/836,750) Examiner: Daniel C. Gamett
)
Filed: April 17, 2001)
)
For: METHOD FOR GROWING)
 MUSCLE IN A HUMAN)
 HEART)

RESPONSE

Sir:

This letter responds to the November 18, 2009 Office Action (hereinafter referred to as “the Office Action”), wherein it was stated at page 3 of the Office Action that claims 236, 238, 239, 244, 247, 250, 251, 253, 257-263, 268-271, 280-285, and 288-290 “are under examination.” However, the PTO did not explicitly provide a basis for a rejection of such claims other than referring to “the rejection of record” at ¶69 of the Office Action. However, the Office Action appears to respond to some of the points raised in Applicant’s Brief filed on June 1, 2009 (hereinafter referred to as “the 6/1/09 Appeal Brief”) rather than explicitly stating the grounds of rejection.

In any event, despite the lack of clarity of the Office Action and because the Office Action addresses the prior rejection of claims 236, 238, 239, 244, 247, 250, 251, 253, 257-263, 268-271, 280-285, and 288-290 under 35 U.S.C. §112, first paragraph, as lacking enablement, Applicant assumes that the PTO intended to repeat the complete rejection. However, the nature and extent that such rejection is repeated is absent from the Office Action thereby compounding the difficulty in submitting the instant Response. The lack of clarity of the Office Action is

further compounded by the fact that the prior rejection also relies upon a subsequent rejection(s) without specific detail.

Applicant notes that the Office Action appears to basically respond to points raised in the 6/1/09 Appeal Brief. Consequently, Applicant is mystified why the appeal needed to be withdrawn and the already unduly lengthy, time consuming examination procedure perpetuated. Surely, the instant application should have been ripe for a decision on appeal regarding already developed issues instead of the PTO creating more issues in the 51-page Office Action. Applicant does not understand why the present PTO Examiner had a need to withdraw the application from appeal and thus compound already developed issues with additional argumentation, especially in view of the numerous office actions and changes in position by the PTO since the filing of this application almost nine years ago.

Applicant further notes that the present PTO Examiner withdrew the appeal in view of the 6/1/09 Appeal Brief and re-opened prosecution of the instant application. Such withdrawal marks the second time that the PTO has withdrawn the instant application from appeal following the filing of an appeal brief by Applicant. Such series of withdrawals exacerbates rather than advances prosecution of the instant application, as dictated by the compact prosecution objectives of the PTO. These series of withdrawals have resulted in unnecessary and considerable delays causing onerous expense to both Applicant and the PTO. The uncertain nature of the prosecution of the instant application has involved the creation of many irrelevant issues and changes in positions of the PTO with the resultant effect of obscuring relevant issues and unnecessarily complicating the various grounds of rejection. The same problem exists within Applicant's related co-pending applications and between the instant application and such applications. It would markedly improve the quality of the prosecution for all of these applications if the PTO would adopt a consistent position between all such applications from which appeals can be taken.

This second withdrawal from appeal of the instant application appears to be part of a pattern directed at this and other related applications of Dr. Elia. For example, appeals were withdrawn by the PTO three times in the prosecution of patent application Serial No. 09/064,000; two times in Serial No. 09/794,456; and two times in Serial No. 10/179,589. This amounts to a total of nine (9) such withdrawals. Such consistent pattern of withdrawals from appeal does not appear to Applicant to be mere coincidence. A further factor that has contributed to the PTO's inability to reach a final position from which Applicant can lodge an appeal is the apparent reference back to and, perhaps, incorporation of, prior Office Action(s) into the present Office Action without any meaningful identification of which portions of such prior Office Action(s) continue to be relied upon. For example, it is not clear in the Office Action that the enablement rejection or portion thereof was maintained for all reasons of record. In view of the extensive prosecution history of this application, there is the obvious need to clearly delineate which portions of prior Office Action(s) that are currently relied upon by the PTO. In the office action prior to the instant Office Action, this is manifestly evident. Such practice is frowned upon by the PTO for obvious reasons.

Being that the relied-upon portions of the prior office actions, if any, have not been specifically identified, Applicant believes that there is no other option than to repeat appropriate sections of the 6/1/09 Appeal Brief. For the convenience of the PTO, repeated sections will be referenced by referral to the October 2, 2008 Office Action (hereinafter "the 10/02/08 Office Action").

In any event, Applicant requests favorable reconsideration for the substantive reasons set forth below.